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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,456	09/19/2006	Iain Baird Smith	06-744	8844

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EXAMINER	
PHULIC, DANIEL T	

ART UNIT	PAPER NUMBER
3662	

MAIL DATE	DELIVERY MODE
02/17/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,456	SMITH ET AL.	
	Examiner	Art Unit	
	Dan Pihulic	3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20070417*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

2. With respect to claim 8-10 and 16-18, a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for; "

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

In the instant case:

Claim 8, line 2, recites "means (12) for generating and detecting returns", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 8 is considered indefinite.

Claim 8, lines 3 and 5, recite "processing means", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 8 is considered indefinite. The specification only discloses a general purpose processor and not a special purpose computer programmed to perform the claimed function.

See Aristocrat, 521 F.3d 1328 and Ex parte Catlin, 90 USPQ2d 1603 (BPAI 2009)(precedential).

Claim 9, line 1, recites "means for generating and detecting returns", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 9 is considered indefinite.

Claim 10, line 2, recites "processing means", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 10 is considered indefinite. The specification only discloses a general purpose processor and not a special purpose computer programmed to perform the claimed function.

See Aristocrat, 521 F.3d 1328 and Ex parte Catlin, 90 USPQ2d 1603 (BPAI 2009)(precedential).

Claim 16, lines 1 and 2, recite "means (12) for generating and detecting returns", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 16 is considered indefinite.

Claim 16, lines 3 and 5, recite "processing means", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 16 is considered indefinite. The specification only discloses a general purpose processor and not a special purpose computer programmed to perform the claimed function.

See Aristocrat, 521 F.3d 1328 and Ex parte Catlin, 90 USPQ2d 1603 (BPAI 2009)(precedential).

Claim 17, line 1, recites "means for generating and detecting returns", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 17 is considered indefinite.

Claim 18, line 2, recites "processing means", which is not defined in the claim and does not appear to be defined in the specification by sufficient structure, thus claim 18 is considered indefinite. The specification only discloses a general purpose processor and not a special purpose computer programmed to perform the claimed function.

See Aristocrat, 521 F.3d 1328 and Ex parte Catlin, 90 USPQ2d 1603 (BPAI 2009)(precedential).

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP § 608.01(o) and 2181.

3. The following is a quotation of 35 U.S.C. 101 that reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 and 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The aforementioned method claims fail to meet the following requirements because they are not tied to another statutory class of invention or transform underlying subject matter (such as an article or materials) to a different state or thing. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584,588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP03248077/JP27501911. The references disclose the utilization of clutter maps and cells as recited in the aforementioned claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pihulic whose telephone number is 571-272-6977. The examiner can normally be reached on Tuesday through Thursday and every other Monday and Friday from 5:30 a.m. to 4 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza, can be reached on 571-272-6979.

The fax phone numbers for the organization where this application or proceeding is assigned are:

571-273-8300 for official responses, and

571-273-6977 for unofficial communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the telephone number 800-786-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/Dan Pihulic/
Primary Examiner, Art Unit 3662